

REMARKS

Request to Correct Inventorship

A Request to Correct Inventorship to add inventor Teng Pin Poo was filed on May 20, 2004. Applicants respectfully request that the Director issue a decision on the Request and issue an updated Filing Receipt showing both Chong Seng Cheng and Teng Pin Poo as the joint inventors.

Rejection for Non-Statutory Double Patenting

The Examiner provisionally rejected claims 22, 24, 29, and 30 based upon non-statutory obviousness-type double patenting as being unpatentable over co-pending Application No. 11/928,009 and/or Application No. 11/926,505. Applicants are enclosing Terminal Disclaimers and respectfully request that this rejection be withdrawn.

Rejections under 35 U.S.C. § 112

The Examiner rejected “[c]laim 1” under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have taken the Examiner’s reference to “[c]laim 1” as having been intended to refer to claim 22. Applicants respectfully traverse.

The Examiner stated that the specification as originally filed does not support the limitation “...having a memory space at least as large as the memory space of the magnetic disk or CD,” recited in claim 22. Applicants submit that support for this limitation can be found on page 5, lines 11-14 of the specification. This portion of the specification states “[t]he device 10 also includes a USB socket 8 that is coupled directly to the USB plug 1 and permits the other USB devices to be coupled to the USB via the device 10. For example, if a user wishes to increase memory space, a USB plug 1 of a second memory device 10 may be connected to the

USB socket 8.” This disclosure discloses to the skilled artisan that the memory device 10 has a certain memory space, which can be increased by connecting a second memory device 10 to a first memory device 10.

Further, support for this limitation can be found on page 2, lines 6-11 of the specification, which states that “[a]n advantage of the invention is...to provide a portable data storage device which...does not include moving parts or require a mechanical drive mechanism to read the data....” This passage, read in light of page 1, lines 13-22 of the specification, identifying then-existing storage devices such as magnetic disks and CD-ROMs as deficient due to, for example, their “bulky and/or delicate moving parts,” provides support for the claim limitation. To replace an existing device which has particular deficiencies with a new device addressing those deficiencies, the new device must not only address those deficiencies, but it must also be capable of performing substantially the same function as the existing device. Here, the claimed portable data storage device addresses not only the deficiencies of the bulk and/or delicate moving parts of magnetic disk and CD-ROM systems, but also is capable of storing at least as much data as those devices. To serve as an effective replacement for magnetic disks and CD-ROMs, the claimed portable data storage device must have a memory space that is at least as large as a magnetic disk or CD-ROM.

Support for this limitation can also be found on page 4, lines 19-25 of the specification, which discloses that in one embodiment the flash memory 4 can be divided into zones. This portion of the specification states that one of the zones “can be used typically for storing a user’s data.” Because the memory 4 is capable of being divided into at least two zones, where one zone can be used for storing a user’s data, the memory 4 necessarily has sufficient memory space to enable user data to be stored in a portion (zone) of the memory.

Because the specification discloses that the portable data storage device has a certain memory space, is intended to replace a magnetic disk or CD-ROM, and can store user data in a portion (zone) of its memory space, the limitation "...having a memory space at least as large as the memory space of the magnetic disk or CD" is supported by the disclosure of the specification. Applicants respectfully submit that the as-filed specification satisfies the written description requirement of § 112, first paragraph, and request that the rejection of claim 22 under § 112 be withdrawn.

The Examiner also rejected claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse.

The Examiner stated that the specification as originally filed does not support claim 22 insofar as claim 22, in the Examiner's words, "compares the size of the memory to a magnetic disk or CD," because the size of these devices could vary. The Examiner further stated that "[t]he limitation '...to serve as an alternative to a magnetic disk or CD' does not help to define the size of a magnetic disk or CD because a storage medium of even a single bit, byte, or etc. can be used to serve as an alternative to a magnetic disk or CD."

Applicants respectfully submit that a storage medium of a single bit or single byte cannot serve as an effective alternative to a magnetic disk or CD. As explained above, to serve as an effective replacement for magnetic disks and CD-ROMs, the claimed portable data storage device must have a memory space that is at least as large as a magnetic disk or CD-ROM. Further, at the time of the invention it was well known that a memory size of a magnetic disk was approximately one megabyte. See Hyde Affidavit, ¶ 13.

The fact that the storage capacity of a magnetic disk or CD can vary does not automatically render claim 22 indefinite. See MPEP 2173.05(b). "Acceptability of the claim

language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” *Id.* One of ordinary skill in the art would understand that the phrase “a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD” defines a memory space having at least as much capacity as a magnetic disk or CD. One of ordinary skill in the art would also be well aware of the finite number of storage capacities of existing magnetic disks or CDs. Thus this limitation is definite.

The Examiner also stated that the specification as originally filed does not support the limitation “...capable of storing software for installation to the computer or of receiving and storing...,” recited in claim 22, because this limitation does not clearly articulate whether the invention actually does this or is simply capable of doing this.

Applicants respectfully submit that the plain meaning of the phrase “capable of” is that the claimed portable data storage device has the capability to store software. With respect to the Examiner’s question whether the claimed storage device “actually does” store software, Applicants respond that, because the claimed storage device is “capable of” storing software, it can “actually” do so at the direction of a user. One of ordinary skill in the art would understand that “capable of storing software” as used in the preamble of claim 22 is definite in expressing the portable data storage device’s ability to store software if a user so chooses.

Applicants respectfully submit that claim 22 satisfies the requirements of § 112, second paragraph, and thus is not indefinite. Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. § 102(e)

The Examiner rejected claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,748,541 to Margalit et al. Applicants respectfully traverse.

Claim 22 recites a unitary portable data storage device that comprises a non-volatile solid-state memory having a memory size at least as large as the memory size of a magnetic disk or CD, and a memory controller to control storage of data in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD, the data including at least user data that is not authorization data. Margalit does not disclose a data storage device that is able to serve as an alternative to a magnetic disk or CD. Margalit also does not disclose a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD.

Margalit discloses a device to be used by mobile users to interact with flexibly connectible computer systems ("FCCS"). *See, e.g.*, Margalit, col. 2, lines 9-18; lines 22-29. Margalit discloses a device designed to store mobile user identity information, and this FCCS device does not have a memory with a memory size at least as large as the memory size of a magnetic disk or CD. Margalit does not disclose that the FCCS device can serve as an alternative to a magnetic disk or CD. Thus Margalit does not anticipate claim 22.

Claim 22 recites "a non-volatile solid-state memory... having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD." Margalit does not disclose this limitation. Margalit does not disclose a device that can "serve as an alternative to a magnetic disk or CD." Margalit discloses a device that is analogous to a memory smart card. Margalit, col. 4, lines 20-22. The FCCS device stores "information characterizing the mobile user," where

the “information characterizing each mobile user comprises sensitive information.” Margalit, col. 2, line 27; col. 3, lines 2-3. “The token may authenticate information and/or store passwords or electronic certificates in a token which may be the size of a domestic house key. Preferably, when the token is inserted into a flexible connection providing port, a highly secure ‘dual factor authentication’ process . . . takes place in which (a) the electronic token is ‘read’ by the host PCC or network and (b) the user types in his or her personal password for authorization.” Margalit, col. 3, lines 41-50. The Margalit FCCS device is a type of electronic key to control access to a host computer or network and protect confidential information.

As shown in a 1998 press release from Aladdin (the assignee of the Margalit patent), the purpose and function of the Aladdin USB smart card device is to provide software security. See Exhibit A, “Aladdin Announces SmartHASP Software Protection on a Smart Card,” Business Wire Press Release, July 2, 1998. Even today, the Aladdin USB smart card devices use the two-factor authentication disclosed in Margalit for “user authentication, password management, secure digital signatures, and data security solutions.” See Exhibit B, “eToken Pro Smart Card – Security and Strong Two-Factor Authentication”; Exhibit C, “Aladdin eToken Pro Usbkey”; and Exhibit D, “Aladdin eToken Pro USB 72k – USB security key.” The purpose and function of the Aladdin devices is clearly providing security to data and software.

In contrast, the purpose and function of a magnetic disk or CD is to store data, and to enable transfer of data from one computer to another. See Kim Affidavit, ¶¶6-10. A magnetic disk or CD has a function that is clearly different than that of a USB smart card token device as disclosed in Margalit. As the portable data storage device of claim 22 can “serve as an alternative to a magnetic disk or CD,” it too has a different purpose and function than the USB smart card token of Margalit. The portable data storage device of claim 22 provides data storage.

See e.g., Hyde Affidavit, ¶ 24 (noting statements by the industry recognizing the benefits of Applicants' storage device). The device disclosed by Margalit does not have the same structure, purpose, or function as the claimed portable data storage device, and thus Margalit does not disclose a portable data storage device that is able "to serve as an alternative to a magnetic disk or CD."

Margalit's disclosure of a FCCS smart card token device that uses "dual factor authentication" to protect software or data does not teach or disclose a portable data storage device that comprises a memory and a memory controller that enable the portable data storage device to serve as an alternative to a magnetic disk or CD. Margalit's FCCS device that is analogous to a smart card is not a mass storage device that can serve as an alternative to a magnetic disk or CD.

Further, Margalit does not disclose a device with a memory space "at least as large as the memory space of a magnetic disk or CD." Although, as the Examiner noted, Margalit discloses that the FCCS device can store confidential medical information (col. 7, lines 13-16), there is no disclosure that storage of this information requires a memory space of any particular size. This portion of Margalit does not disclose that the FCCS device has a memory with a memory space that is "at least as large as the memory space of a magnetic disk or CD." Margalit discloses that storing confidential medical information is one of many smart card security functionalities that the FCCS device is intended to provide. Margalit, col. 7, lines 5-16. Applicants respectfully submit that, at the time of the invention, it was well known that the memory space of a smart card was very small (up to only 1 kilobyte) and that a memory size of a magnetic disk was approximately one megabyte. See Hyde Affidavit, ¶¶ 13 & 21. Even today, devices manufactured by the assignee of the Margalit patent (Aladdin) have a memory capacity of less

than one megabyte. See Exhibits B-D (showing Aladdin USB smart card devices having a memory capacity of 72 kilobytes). Thus, Margalit does not disclose a device having a memory space “at least as large as the memory space of a magnetic disk or CD.”

The Examiner cited the decision of the Board of Appeals and Interferences, page 8, where the Board stated “we do not see why the capacity, if interpreted to refer to an amount of memory, requires more than a single byte (or bit) of memory,” as support for its argument that Margalit discloses the limitation “... having a memory space at least as large as the memory space of a magnetic disk or CD.” However, Applicants submit that the Board was considering a prior version of claim 22, which did not include the present limitation “... having a memory space at least as large as the memory space of a magnetic disk or CD.” Again, Applicants respectfully submit that, at the time of the invention, it was well known that a memory size of a magnetic disk was approximately one megabyte. See Hyde Affidavit, ¶ 13. Thus, because a “single byte (or bit)” is not at least as large as the memory space of a magnetic disk or CD, the Examiner’s reliance on this reasoning was misplaced.

Margalit does not disclose all of the limitations of claim 22. Applicants respectfully submit that claim 22 is not anticipated by Margalit and is in condition for allowance. Claims 23, 24, and 26-28 depend from claim 22, and thus are also not anticipated by Margalit and are in condition for allowance.

Rejection under 35 U.S.C § 103(a)

The Examiner rejected claims “29 and 20” under 35 U.S.C. § 103(a) as being unpatentable over Margalit in view of U.S. Patent No. 6,407,949 to Jha et al (hereinafter Jha). Applicants have taken the Examiner’s reference to “claim 20” as having been intended to refer to claim 30. Applicants respectfully traverse.

As discussed above, Margalit does not disclose each and every limitation of the parent claim 22, and thus does not disclose each and every limitation of claims 29 and 30, which depend from claim 22 and incorporate all of its limitations. Further, one of ordinary skill in the art would have no reason to modify the device of Margalit to include a set of flash macros as disclosed by Jha. Margalit's small memory would be wholly inconsistent with the division of an already very small memory into a set of flash macros, as disclosed in Jha.

Claim 29 recites "the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection received via the USB plug." Jha does not disclose this limitation. Jha discloses an ASIC that includes a flash memory array 130 including flash memory cells defining up to N different flash macros which can be independently accessed. Jha, col. 7, lines 54-58. However, Jha does not disclose that each of the flash macros is selectively accessible in response to a zone selection received via a USB plug. The flash macros of the Jha ASIC are accessed according to requests from the microprocessor or other component of the ASIC itself (Jha, col. 11, lines 2-3), not from a zone selection received from outside of the ASIC. Thus Jha does not disclose this limitation.

One of ordinary skill in the art would have no reason to modify the FCCS device of Margalit to include a flash memory divided into a set of flash macros, as disclosed by Jha. The independently-accessible flash macros of Jha are advantageous in a cellular telephone application because flash memory in an ASIC in a cellular telephone may need to be accessed "much more quickly than is required in other applications," particularly for voice telephone calls, where "any delay necessitated by having to wait for a previous write operation to be completed before reading from the flash memory may be significant." Jha, col. 2, lines 17-25. However, there is no disclosure in Margalit that its memory may need to be accessed "much more quickly"

than required in other applications, or that any delay by having to wait for a previous write operation to be completed before reading from the memory may be significant. Thus, there would be no need to add, and no benefit in adding, a memory divided into a set of flash macros as disclosed in Jha to the USB smart card token device of Margalit.

Neither Margalit nor Jha, alone or in combination, discloses all of the limitations of claim 29. Further, one of ordinary skill in the art would have no reason to modify the device of Margalit to include a set of flash macros as disclosed by Jha. Applicants respectfully submit that claim 29 is not obvious in view of the cited references and is in condition for allowance. Claim 30 depends from claim 29 and is therefore allowable for at least the same reasons.

Conclusion

Based on the foregoing remarks, Applicants respectfully submit that all pending claims in the present application are in condition for allowance and respectfully request the issuance of a Notice of Allowance. If a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Applicants' attorney at the number listed below.

Respectfully submitted,

Dated: April 5, 2011

By: /Warren S. Heit/
Warren S. Heit (Reg. No. 36,828)
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EXHIBIT A



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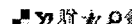
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Aladdin Announces SmartHASP Software Protection on a Smart Card.

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TEL AVIV, Israel--(BUSINESS WIRE)--July 2, 1998--

Industry-Leading Security with Unparalleled Ease-of-Use

Aladdin Knowledge Systems Ltd. (NASDAQ: ALDNF), a leading developer of solutions for the secure licensing and distribution of digital content, today announced SmartHASP(TM), the latest addition to HASP, the industry-leading hardware-based software protection system.

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SmartHASP combines the traditional security of HASP with the up-to-the-minute technology of smart cards, building on Aladdin's reputation as a leader both in software protection and smart card development.

"With the announcement of USBHasp and Hardlock-USB, we confirmed our position as the innovators in the field of software security. Now SmartHASP takes us one stage further, providing next-generation solutions for managing and controlling network-based applications," says Aladdin's VP R&D Ramji Kasterstein.

SmartHASP utilizes a CPU-based smart card with 496 bytes of internal read/write memory that can control access to different software modules, save passwords or other sensitive data. Such features facilitate innovative marketing and distribution techniques such as time-limited, demo, rental or leased software and have been field-proven by MemoHASP, Aladdin's most popular mainstream protection key.

SmartHASP works in conjunction with a PC/SC compliant read/write drive, and with Aladdin's ASEDrive. The integration of smart card drives into PCs is becoming more widespread in network environments. System integrators recognize the versatility of smart cards across a wide range of applications particularly appropriate to security-conscious networks. These range from simple PC-access control through to sophisticated authentication procedures based on biometric recognition.

The problem of protecting software on networks was highlighted by the 1998 BSA/SPA study which

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showed that 40% of office software was in illegal use.

"We believe that SmartHASP will further prove to developers and end-users that software protection is simple to implement, transparent in operation and an effective barrier to piracy," comments Rami Kasterstein.

About Aladdin:

Aladdin Knowledge Systems is a global leader in the secure licensing and distribution of digital content. Aladdin's product range includes HASP(R) and Hardlock(R), key-based software security systems which monitor software licensing and prevent unauthorized use of computer programs, Privilege(TM), a suite of software licensing and metering tools for developers and corporate IT managers, and ASE(R) -- The Aladdin Smartcard Environment -- a set of smart card application development tools for integrating smart cards with PCs. Aladdin is an ISO 9002 accredited company with headquarters in Tel Aviv, Israel, 5 international offices and distributors in more than 40 countries, serving over 25,000 clients worldwide. For more information, visit the Aladdin home page at <http://www.aks.com>.

CONTACT: Aladdin Knowledge Systems Inc., New York

Peter Felgentreff, 212/564-5678
Fax: 212/564-3377
E-mail: peter.felgentreff@us.aks.com
or
Aladdin Knowledge Systems Ltd., Tel Aviv

Lisa Appelton, 972-3/636-2222
Fax: 972-3/537-5796
E-mail: lisa.appelton@aks.com

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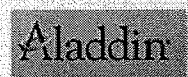
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eToken PRO Smartcard – Security and Strong Two-Factor Authentication

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eToken PRO Smartcard is your card for strong user authentication, password management, secure digital signatures and data security solutions. It also provides easy integration into Public Key Infrastructure (PKI) architectures, enabling secure portable storage of keys and guaranteed non-repudiation for sensitive applications such as online banking, stock trading, and e-commerce. eToken PRO Smartcard leverages the functionality of Aladdin's **industry-leading USB token, eToken PRO**, in a convenient, secure card form factor. It is ideal for users looking for a strong authentication and password management solution with magnetic stripe, and photo ID for visual identification.

Why eToken PRO Smartcard?

Extremely Secure

eToken PRO Smartcard provides native support for RSA 2048 keys and enhances security by generating and storing users' personal credentials such as private keys, passwords and digital certificates inside the protected environment of the smart card chip. Users' private keys never leave the token!

Highly flexible

eToken PRO Smartcard supports all eToken PKI and single sign-on applications, as well as software development tools for seamless integration with third party applications. The token functionality can be extended to be used with your custom applications through the loading of Java applets on-board the tokens. In addition, eToken PRO Smartcard can be customized to include RFID, magnetic stripes, logos, ID photos and more.

Easy to implement

By supporting industry standard security interfaces and systems, eToken PRO Smartcard ensures easy integration with your organization's current infrastructure and security strategy.

Easy to use

In order to authenticate, users need only insert their eToken PRO Smartcard into the smart card reader and enter the eToken password.

Specifications

Supported operating systems Windows 2000/XP/2003/Vista Mac OS X; Linux

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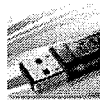
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API & standards support	PKCS#11 v2.01, Microsoft CAPI, PC/SC, X.509 v3 certificate storage, SSL v3, IPSec/IKE
Memory Size	72K (Java Virtual Machine)
On board security algorithms	RSA 1024-bit / 2048-bit, DES, 3DES, SHA1
Security certifications	In evaluation: FIPS 140-2 and CC EAL4+ PP-SSCD. Common Criteria EAL4+ (smart card chip).
ISO specification support	Support for ISO 7816-1 to 4 specifications
Memory data retention	At least 10 years
Memory cell rewrites	At least 500,000

* eToken PRO Smartcard 32K, 64K (Siemens CardOS based) is also available. Please inquire for details.



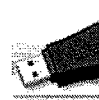
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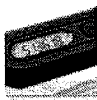
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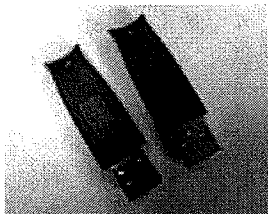
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EToken PRO can generate and store users' personal credentials, such as private keys, passwords and digital

Certificates, inside the protected environment of the smart card chip. To authenticate users must supply both

Their personal eToken device and eToken password, providing a critical added level of security to your digital business resources.

Cost-effective and easy to use, eToken PRO is a portable, reader-less smart card that users can take with them

Wherever they go and plug into any computer with a USB port. With its advanced on-board cryptographic processing capabilities, security certifications and physical tamper-evident and water-resistant casing, eToken PRO is ideal for your corporate network and eBusiness security needs.

Features:

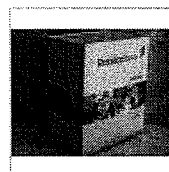
- 1 Highly secure smart card chip; Common Criteria certified
- 2 On-board RSA 1024-bit and 2048-bit key generation, authentication & digital signing
- 3 Standard Microsoft CAPI and PKCS#11 support
- 4 Secure storage and robust file system
- 5 Hardened tamper-evident and water-resistant shell
- 6 Standard USB interface
- 7 Integrated secure logical and physical access with proximity coils Embedded in the eToken devices
- 8 Flexible customized color, security coding and logo printing options

Benefits:

- 1 Secure storage of users' credentials, keys and sensitive information
- 2 Portable USB design: No special reader needed
- 3 High level of identity assurance: Private keys are never exposed outside the eToken
- 4 Simple deployment: Out-of-the-box connectivity to mainstream security applications via standard security interfaces
- 5 Straightforward integration with third party applications using eToken development tools
- 6 Possible to extend token functionality to be used with your custom applications through loading of Java applets on-board the token*

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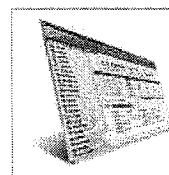
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Language English

Version:

Type: Professional Software

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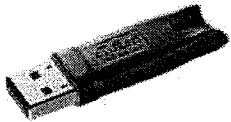
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EXHIBIT D

Aladdin eToken Pro USB 72k - USB security key (10 years)Mfg # **ETPRO72K13511** | Softchoice # **GH2594** | UNSPSC # **43211600****PRODUCT HIGHLIGHTS**

- USB security key (10 years)

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Whether you are looking for strong user authentication, password management, secure digital signatures or data security solutions for your organization, you need a smart card-based device. And if it is a highly secure, cost-effective device you are looking for, the eToken PRO USB token is definitely for you. At the size of an average house key, eToken PRO is your key to strong two factor authentication, password management and secure PKI implementation for your organization.

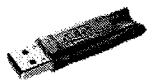
Tech specs

System Requirements

OS Required Linux, Apple MacOS X, Microsoft Windows 2003, Microsoft Windows Vista / 2000 / XP

MiscellaneousCompliant Standards ISO 7816, IEC 60529 IPX8, EAL 4, SHA-1, RSA-1024, Triple DES, RSA-2048, DES
Hardware Token Lifetime 10 years**Interface Provided**

Connector Provided 4 pin USB Type A x 1

GeneralProduct Type USB security key
Product Material Plastic**Environmental Parameters**Min Operating Temperature 32 °F
Max Operating Temperature 158 °F**Helpful Tools:**» Leasing information
» Returns information**Last Viewed Items**» Aladdin eToken Pro
USB 72k - USB
security key (10 years)**Please call for
pricing.**